

Response
Serial No. 10/798,553
Attorney Docket No. 053435

REMARKS

Claims 1-6, 8-11, 13 and 16-20 are pending in the present application. Claims 1-6, 8-11 and 13 are rejected.

Applicants' Response to Claim Rejections under 35 U.S.C. §102

Claims 1-6, 8-11 and 13 were rejected under 35 U.S.C. §102(b) as being anticipated by Murata et al. (U.S. Patent No. 5,302,463).

It is the position of the Office Action that Murata discloses the invention as claimed. The Office Action states that the rejection over Murata in the Office Action dated December 13, 2005 is repeated.

In the Amendment filed on April 13, 2006, in response to the December 13, 2005 Office Action, independent claim 1 was amended to recite that "the rough surface portion is further provided on at least one of the surfaces inside the groove in the side wall portion." Applicants submitted that Murata does not disclose or suggest such a feature.

In the pending Office Action, it is stated that:

Murata points out the inside of the glass run channel may also be provided in the groove in a relatively broad space (col. 20, lines 28-40). Therefore, the rough surface portion extends beyond the contact points and incorporates the side wall portion. Furthermore, Applicant does not claim whether the rough surface portion extends over the entire side wall or just the portion, like the corner. Pages 2-3.

It appears that it is the position of the Office Action that the contacting portion 16 of Murata extends beyond the area discussed in the specification and illustrated in Figures 1, 4 and 5 to the corners of the side walls and top wall. The Office Action appears to broadly interpret such

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corners to be a part of a side wall. It is noted that the “relatively broad space” in Murata refers to sharkskin pattern formed on the draining portions 3, not the side or top walls. Column 20, line 33.

In response, Applicants respectfully submit that Murata does not disclose a rough surface portion on the side wall portion. Murata specifically discloses “a portion 16 in side said channel, against which the end of the window glass is hit, and this portion 16 may also be coated on its surface with the lubricating resin layer 9.” Column 20, lines 36-39. As illustrated in Figure 5, the window glass 12 hits the top wall of the main body 2 of the glass run channel. It appears that the portion 16 is composed of a substance similar to that of contacting portion 4.

Figure 5 of Murata clearly illustrates that the portion 16 extends slightly beyond the width of the window glass 12. However, Murata does not disclose that the portion 16 is present on the corners between the side walls and top wall, or anywhere in the vicinity of such a corner. Although cited art drawings may not be relied upon for scale unless specifically stated, “the description of the article pictured can be relied on, in combination with the drawings, for what they would reasonably teach one of ordinary skill in the art.” MPEP §2125. The combination of the drawings and the specification would only reasonably teach a rough surface area in the vicinity of the contact point of the window glass 12. The Office Action has established no reason why the drawings or specification of Murata teach a rough surface portion on a side wall as claimed, or even on the corners as argued. Such a construction is not illustrated in the Figures, is not discussed in the specification, and is not even suggested in the specification. Therefore, Murata does not explicitly disclose a rough surface portion on a side wall.

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Furthermore, Murata does not inherently disclose a rough surface portion on a side wall.

It is noted that:

To establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.’ *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted).

A rough surface portion on a side wall is not necessarily present in Murata. Rather, the theoretical presence of such a rough surface portion on a side wall is merely based on speculation by the Office Action. Therefore, Murata does not inherently disclose a rough surface portion on a side wall.

Additionally, the use of a rough surface portion on a side wall would not have been obvious in Murata. In the present application, rough surface portions 254 and 255 are disposed on side walls 22 and 23, respectively. These rough surface portions are utilized to ensure that the lip portions 26 and 27 do not stick to the side walls 22 and 23. Further, these rough surface portions help to reduce noise. See page 51, line 20 to page 52, line 2. No such problems or solutions are discussed in Murata. Thus, there is no suggestion or motivation in Murata to provide a rough surface portion on a side wall.

For at least the reasons discussed above, Murata does not disclose or suggest a rough surface portion being disposed on a side wall. “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Constant v. Advanced Micro-Devices, Inc.*, 848 F.2d 1567, 7 USPQ2d 1057

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(Fed. Cir. 1988) (emphasis added). Since Murata does not explicitly or inherently disclose each and every element of claim 1, Murata cannot anticipate claim 1. Accordingly, claim 1 and all claims dependent thereon are not patentable over Murata. Furthermore, the recited construction of a rough surface portion on a side wall would not have been obvious in view of Murata. Applicants respectfully traverse the rejection. Favorable reconsideration is respectfully requested.

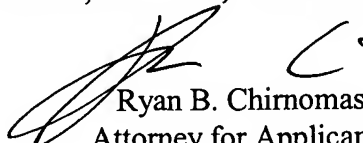
For at least the foregoing reasons, the claimed invention distinguishes over the cited art and defines patentable subject matter. Favorable reconsideration is earnestly solicited.

Should the Examiner deem that any further action by applicants would be desirable to place the application in condition for allowance, the Examiner is encouraged to telephone applicants' undersigned attorney.

If this paper is not timely filed, Applicants respectfully petition for an appropriate extension of time. The fees for such an extension or any other fees that may be due with respect to this paper may be charged to Deposit Account No. 50-2866.

Respectfully submitted,

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